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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,036	03/19/2001	Ian M. Drysdale	FDC 0502 PUS	9345
20350	7590	06/06/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			BOUTAH, ALINA A	
TWO EMBARCADERO CENTER			ART UNIT	
EIGHTH FLOOR			PAPER NUMBER	
SAN FRANCISCO, CA 94111-3834			2143	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/812,036

Applicant(s)

DRYSDALE ET AL.

Examiner

Alina N Boutah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-28 and 38-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-28 and 38-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

ND

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to Applicant's amendment filed November 30, 2004. Claims 1-17 and 29-37 have been cancelled. Claims 18, 27 and 28 have been amended. Claims 38-44 have been newly added. Claims 18-28 and 38-44 are pending in the present application.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 4, 2005 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-28 and 38-44 are rejected under 35 U.S.C. 102(e) as being anticipated by USPAPN 2002/0095333 by Jokinen et al. (hereinafter referred to as Jokinen).

(Amended) Regarding claim 18, Jokinen teaches a method for a facility communication system in a commercial establishment to provide a targeted electronic communication to a user entering the establishment and having a personal wireless device comprising the steps of:

storing user specific information in a storage location (figure 1);

providing the personal wireless device with a transceiver device (figure 2);

recognizing the presence of the personal wireless device transceiver when the user enters the commercial establishment and the personal wireless device is within a predetermined distance from the facility communication system (figures 8, 10 and 11; abstract; 0005, 0007);

sending a request for user specific information from the facility communication system to the personal wireless device (0044);

retrieving the user specific information (abstract; 0017);

sending the user specific information from the personal wireless device to the facility communication system (0006, 0038);

comparing the user specific information to predetermined criteria (abstract; 0017); and

sending a targeted electronic communication to said personal wireless device corresponding to the user specific information (figure 8); and

displaying the targeted electronic communication at the personal wireless device so that the communication may be used by the user while present in the commercial establishment (abstract; figures 6, 10 and 11).

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Regarding claim 19, Jokinen teaches the method of claim 18 further including the step of notifying said user that a targeted electronic communication has been received by said personal wireless device (0055).

Regarding claim 20, Jokinen teaches the method of claim 18 wherein said step of storing user specific information in a storage location comprises storing the user specific information within said personal wireless device (0038).

Regarding claim 21, Jokinen teaches the method of claim 18 wherein said step of storing user specific information in a storage location comprises storing the user specific information at a remote storage location which is accessible by the personal wireless device (0038).

Regarding claim 22, Jokinen teaches the method of claim 21 wherein the step of retrieving the user specific information comprises retrieving the user specific information from said remote storage location (0038).

Regarding claim 23, Jokinen teaches the method of claim 18 wherein said personal wireless device is a cellular phone (0038).

Regarding claim 24, Jokinen teaches the method of claim 18 wherein said personal wireless device is a pager (figures 2, 5 and 10).

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Regarding claim 25, Jokinen teaches the method of claim 18 wherein said personal wireless device is a personal digital assistant (figures 2, 5 and 10).

Regarding claim 26, Jokinen teaches the method of claim 18 wherein the step of recognizing the presence of the personal wireless device transceiver when the personal wireless device is within a predetermined distance from the facility communication system comprises recognizing the presence of the personal wireless device when the user enters a facility where the facility communication system is located (0006).

Regarding claim 27, Jokinen teaches the system and method of claim 18 wherein said facility communication system is located in the commercial establishment and said targeted communication signal is an e-coupon corresponding to the user specific information for use at the commercial establishment (figure 5).

Regarding claim 28, Jokinen teaches the method of claim 18 wherein said facility communication system is located in the commercial establishment and said targeted communication is an advertisement providing data corresponding to the user specific information and relating to a product found at said commercial establishment ().

Regarding claim 38, Jokinen teaches the method of claim 18, wherein the predetermined criteria is information relating to specific items present at the commercial establishment so that

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the targeted communication pertains to both the user and the items present at the establishment (figure 5, 0050).

Regarding claim 39, Jokinen teaches the method of claim 38, wherein the commercial establishment is a merchant location, and wherein the predetermined criteria is information relating to items for sale that are in inventory at the merchant location, so that the user specific information may be compared to those items in inventory [figure 8; 0050].

Regarding claim 40, Jokinen teaches the method of claim 39, wherein the user specific information is product preferences of the user, and wherein the method further comprises matching user specific information to items in inventory prior to sending the targeted communication to the personal wireless device [abstract; figure 12A].

Regarding claim 41, Jokinen teaches the method of claim 18, wherein the targeted communication is advertising and wherein predetermined criteria is information relating to specific items present at the commercial establishment, so that the advertising pertains to both the user and to items present at the establishment (abstract).

Regarding claim 42, Jokinen teaches the method of claim 41, wherein the advertising is an e-coupon (abstract).

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Regarding claim 43, Jokinen teaches a system for providing targeted advertising from a commercial establishment to a user entering the commercial establishment, comprising:

a personal wireless device carried by the user and including a transceiver device (figures 2 and 5); and

a facility communication system resident at the commercial establishment having a sensing device for recognizing the presence of the personal wireless device transceiver when the user enters the establishment and the personal wireless device is within a predetermined distance from the facility communication system (figures 1, 3B, 6, 8; abstract);

wherein the facility communication system sends a request for user specific information to the personal wireless device when the sensing device senses the presence of the personal wireless device (figure 8);

wherein the personal wireless device sends back to the facility communication system a response data message having the user specific information (figure 3B; 0006);

wherein the facility communication system compares the user specific information to predetermined criteria relating to specific items at the commercial establishment (figure 3B);

wherein the facility communication system sends a targeted electronic communication having advertising to the personal wireless device, the targeted communication pertaining to both the user and items at the commercial establishment (figure 8); and

wherein the personal wireless displays the targeted electronic communication so that the advertising may be used by the user while the present in the commercial establishment (abstract; figures 6, 10 and 11).



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Regarding claim 44, the system of claim 43, wherein the targeted communication further comprises an e-coupon (figure 10).

### ***Response to Arguments***

Applicant's arguments filed March 7, 2005 have been fully considered but they are not persuasive.

In response to Applicant's argument that Jokinen does not show a system that is resident "within a commercial establishment" and is designed to operate by "recognizing the presence of the personal wireless device when the user enters the commercial establishment," the Patent Office respectfully submits that these limitations are being taught in figures 8, 10 and 11 as well as paragraphs 0005 and 0007 of Jokinen reference. Specifically, Jonkinen teaches sending advertisement messages such as electronic coupons to mobile terminals that are nearby establishment/advertising entities such as gas or automotive repair station [0007].

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*ANB*

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DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100